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JAMES H. McKENNEY,

Reply Brf. of Richards for P. E.

IN THE

SUPREME COURT OF THE UNITED STATES.

Filed Nov. 2, 1897.

OCTOBER TERM, A. D. 1897.

HENRY PRATT AND JOHN G. RYAN, PARTNERS AS HENRY PRATT & CO., *Plaintiffs in Error,*
vs.
PARIS GAS LIGHT & COKE COMPANY, *Defendant in Error.*
} *Error to the Supreme Court of Illinois.*

REPLY FOR PLAINTIFFS IN ERROR.

JOHN T. RICHARDS,
Attorney for Plaintiffs in Error.

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Reply for Plaintiffs in Error.

MAY IT PLEASE THE COURT:

The learned counsel for defendant in error, make three contentions in their brief and argument filed herein.

First. That no federal question was necessarily involved in the decision of the State court, and that therefore, this court has no jurisdiction of the writ of error to the Supreme Court of Illinois.

Second. That in this case plaintiffs in error ask no relief under an act of Congress.

Third. That where the question of the validity of a patent

arises collaterally, a State court may properly admit evidence on such question; the second and third contentions we regard as sufficiently answered in the brief already filed.

Upon the first suggestion, we desire to submit a few words in reply.

Reference to the opinion of the Appellate Court, *Pratt & Co.* v. *Paris Gas Light & Coke Co.*, 51 Ill. App. 604, will very clearly show that the decision of the Appellate Court was based almost, if not, entirely, upon the question of infringement. As to every other question raised in the case, that court simply says, "We are inclined to hold," etc., but that court does not hold that the judgment of the trial court would have been affirmed on any of those grounds, but proceeds, "The more difficult question arises from the *apparent fact* that the verdict of the jury may not have been based upon a finding of these matters favorable to the appellee, but upon a finding that the use of this apparatus was an infringement of the patents controlled by the National Gas Light & Fuel Company." * * *

"The appellants insist that the issue thus presented was not within the jurisdiction of the court to try, and that it could be determined only in the courts of the United States."

"If this provision is well taken the judgment must be reversed, and so *the question of vital importance is.*"

"In an action in a State court for the recovery of the price agreed to be paid for the use of a patent, may the defendant for the purpose of showing a failure of consideration, prove that the patent is void because it is an infringement of a prior patent?"

Reference to the opinion of the Supreme Court of Illinois will reveal the fact that the latter court regarded the question of infringement as of paramount importance. In that opinion, the court says: "The more important question, and

the one chiefly relied on by appellants for reversal, arises from the admission of evidence by the trial court tending to show that the patent claimed by appellants, or their apparatus or machine, was an infringement of a patent controlled by the National Gas Light & Fuel Company." [Rec. 198.]

We respectfully, submit therefore, that both Appellate and Supreme Courts were agreed in the conclusion that the question of infringement was necessarily involved in the decision of this case in the State courts.

As to the contention under this head that no "right, privilege or immunity under the Constitution or laws of the United States was properly set up or claimed in the State courts," we deem it sufficient to reply that the opinions of the State courts above referred to, and especially that of the Supreme Court of Illinois, show clearly that the question was properly raised in the State courts.

In the opinion of the Supreme Court, it is said: "It is insisted that this issue was not within the jurisdiction of the State court, and that the question involved fell within the exclusive jurisdiction of the Federal courts—that is to say, that if the issue could be determined in the State courts, it could only be determined after a finding that there was an infringement by the United States court." [Rec. p. 198.] Both the Appellate and Supreme Courts of Illinois regarded the question as properly presented, and it is too late to make a contrary contention in this court. The objection that the assignment of error in the Supreme Court of Illinois was insufficient can not be sustained for the reason that the Supreme Court of the State regarded the same as sufficient and no objection was made to its sufficiency in that court, while an examination of the record will show that it included other assignments of error which were made in the Appellate Court

of Illinois, and which became a part of the record presented to the Supreme Court of the State.

These assignments of error appear on page 191 of the printed record herein, and under the practice in the Supreme Court of Illinois, it was unnecessary to repeat the assignments of error made in the Appellate Court and which were already a part of the record; and we respectfully submit that the cases cited by the counsel for the defendant in error do not sustain their contention, so far as this case is concerned, for the errors which it is claimed were committed by the Supreme Court of Illinois are specifically pointed out, and any objection to the sufficiency of the assignment of errors in the Supreme Court of Illinois should have been made in that court.

Respectfully submitted.

JOHN T. RICHARDS,

Attorney for Plaintiffs in Error.